

d.) Remarks:

The claims are 48-49, 51, 53-58, 60, 61, 63, 64 and 67-73, with claim 48 being independent. Claims 48, 51, 53, 54, 57, 61, 67, 68, 71 and 73 have been amended solely as to matters of form unrelated to patentability. Claims 1-47, 50, 52, 59, 62, 65 and 66 have been cancelled. Reconsideration of the claims is expressly requested.

The Examiner objected to Figs. 2-8 for the reasons expressed in paragraphs 2 and 3 in the outstanding Office Action. Applicants have filed a Request for Approval of Drawing Changes in which it is proposed to amend Fig. 8 to designate Fig. 8 as "Prior Art." In the Request for Approval paper, Applicants have deleted reference numerals 310, 312b, 313a through 313f, 17, 17a, 21, 200, 35 and 5 in Figures 2-8, respectively. A Request form in duplicate, together with the proposed changes in red, is attached. Accordingly, it is submitted that the objection to the drawings has been overcome and should be withdrawn.

The Examiner objected to the disclosure because of alleged informalities as set forth in paragraph no. 4, subparagraphs (1) - (4) of the outstanding Office Action. The specification has been amended to correct minor typographical and syntax errors unrelated to patentability. In particular, the specification at page 130, lines 23-24 has been amended from "blow" to "below." The specification at page 148, line 6 has been amended from "electroconductive support 21" to read, "electroconductive support 201." The trademarks employed in the application have been capitalized.

The Examiner also objected to the disclosure alleging in subparagraph (3) an informality in the specification at page 117, line 27 to page 118, line 1, which discloses an elastic conductive roller having an Asker C hardness. The Examiner argued that it would require undue experimentation for a person with ordinary skill in the art to determine the

hardness recited in the instant claims since the specification did not disclose how the Asker C hardness is determined, nor did the specification state a standard used to determine the rubber hardness. Moreover, the Examiner contended that the experimental conditions under which the Asker hardness is determined are essential subject matter. Applicants respectfully traverse the objection.

Applicants are not claiming that they are the first to invent the concept of Asker hardness. One of ordinary skill in this art would immediately understand what is meant by an elastic conductive roller with an Asker C hardness of at most 50 deg. An elastic conductor roller with a hardness of 55 deg or lower is disclosed in Tomoyuki '878 as measured with an Asker C hardness meter under an load of 600g (Col. 11). An elastic conductive roller with an Asker C hardness measured by a spring type Asker C hardness meter at a 500g load provides a hardness not higher than 45 deg., according to JIS K 6050 in Shimura '549. Incidentally, the common assignee of Shimura '549 (Canon, K.K.), has advised that the "JIS K 6050" should have read - - JIS S 6050 .- - Finally, in U.S. Patent 5,705,258 a sheet is disclosed with an Asker C hardness measured with a spring type hardness tester according to JIS S 6050.

Therefore, an artisan in this field would understand that Asker C hardness for an electroconductive roller is measured with an Asker C spring type hardness meter according to JIS S 6050 at an appropriate load. Asker C hardness is a concept understood by custom and usage in this field by the skilled artisan in accordance with Tomoyuki '878, Shimura '549 (both commonly owned by the instant assignee) and Ohami '258. Applicants submit that experimental conditions for Asker C hardness are well known by the skilled artisan as evidenced by the above references.

The MPEP warns in § 2164.08 that not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. In re Buchner, 18 USPQ 2d 1331 (Fed. Cir. 1991). All that is necessary is that the artisan be able to practice the invention, given the level of knowledge and skill in the art. The art of record

demonstrates that the skilled artisan can determine Asker C hardness using the typical loads disclosed, the JIS S 6050 standard and the disclosure regarding electroconductive elastic rollers found in, for example, of the Tomoyuki '878 patent and the Shimura '549 patent.

The Examiner objected to claims 3, 13, 16, 18, 24-25, 28, 33, 45, 50, 52-53, 61 and 71 on the grounds that appropriate antecedent basis was not present. Claims 3, 13, 16, 18, 24-25, 28, 33, 45, 50 and 52 have now been cancelled. Without agreeing or disagreeing and solely to expedite prosecution, the specification has been amended at page 119, lines 9-12, as need be, to provide appropriate support for claim 61. Claim 71 has been amended pursuant to the supporting disclosure on pages 16, lines 5-6. Claim 53 has been amended and is supported by the specification on pages 149-153. Withdrawal of the objection is respectfully requested.

To resolve the objections to claims 57, 61 and 73 found on paragraph 9 of the Office Action, claims 57, 61 and 73 have been amended as suggested by the Examiner. Withdrawal of the objection is respectfully requested.

Claims 20, 23, 31, 50-52, 54, 59 and 68 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The reasons for the rejections are set forth on pages 13 - 15 of the Office Action. Without agreeing and to expedite prosecution, claims 51, 54, 59 and 68 have been amended to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Cancellation of Claims 20, 23, 31, 50, 52 and 59 renders their rejections moot. Withdrawal of the rejections is therefore

respectfully requested. Cancellation of Claims 31, 52 and 59 renders the rejections under 35 U.S.C. §112, first paragraph, moot.

Claims 48, 50-60 and 63-73 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Publication No. 2002-00115012 A1 (Hashizume).

Claims 48, 50-53, 55-58, 63-65 and 68-73 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. 5,729, 800 (Ohba). Claims 1-25, 27-37, 41, 42 and 44-47 were rejected under 35 U.S.C. 103 (c) as unpatentable over European Patent 1,128,225 A2 (EP '225) in view of Ohba. Claims 38-40 were rejected under 35 U.S.C. 103(a) as unpatentable over EP'225 in view of Ohba and U.S. 6, 026, 260 (Aita). Claim 43 was rejected under 35 U.S.C. 103(a) as unpatentable over EP'225 in view of Ohba and U.S. 5,998,008 (Shimamura). Claims 48-53, 55-64 and 68-73 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP'225 with Ohba. Claim 54 was rejected under 35 U.S.C. 103(a) as unpatentable in view of EP '225 with Ohba and European Patent 0,989,470 A2 (EP '470). Claims 65-67 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP '225 with Ohba and Aita.

Claims 1-25, 27-36, 41-42 and 44-47 were provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-57 of co-pending Application No. 09/788, 399. Claim 26 was also provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-57 of co-pending Application No. 09/788, 399, in view of Ohba and EP'470. Claims 37-40 were provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-57 of co-pending Application No. 09/788, 399, in view of Ohba and Aita. Claim 43 was provisionally rejected under obviousness-type double patenting as being unpatentable over

claims 1-57 of co-pending Application No. 09/788, 399, in view of Ohba and Shimamura.

Applicants respectfully traverse the grounds of rejections.

Prior art and obviousness type double patenting rejections relating to Claims 1-47 have been rendered moot based upon their cancellation.

Hashizume '012 has been removed as a reference by the filing of a certified English translation of the instant Japanese priority Application No. 348,146/2000 filed November 15, 2000, which provides adequate support for the instant claimed invention.

Ohba '800 does not teach the limitations set forth in amended claim 48 which provide that the charging member is selected from a group consisting of (i) a roller member having an Asker C hardness of at most 50 deg, ii) an electroconductive brush member supplied with a voltage to charge the image-bearing member, and (iii) a charging member having a magnetic brush formed of magnetically constrained magnetic particles having a volume-basis median diameter of 10-50. Support for the amendment is found in original claims 59, 62 and 66 and on page 112, lines 12-27 to page 113, lines 1-9, page 117, lines 25-27 to page 118, line 1; page 120, lines 24-27, page 121, lines 16-25 of the specification. Therefore, Ohba '800 fails as an anticipation.

The rejection based on EP'225 combined with Ohba has been rendered moot by the filing of the certified English language translation of the instant priority application establishing an invention date of November 15, 2000 which is earlier than the EP '225 publication date of August 29, 2001.

Therefore, it is requested that the claims be allowed and the case passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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